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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,503	08/05/1999	LARREN F. JONES	51291.81516	5616

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BANNER & WITCOFF LTD  
1001 G STREET NW  
ELEVENTH FLOOR  
WASHINGTON, DC 200014597

EXAMINER

BATSON, VICTOR D

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 11/21/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/368,503

Applicant(s)

JONES ET AL.

Examiner

Victor Batson

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 10, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-118 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-73 is/are allowed.
- 6) ☒ Claim(s) 74-118 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

***Copy of Patent***

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Reissue Applications***

2. Claims 74-118 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. The subject matter previously surrendered during the prosecution of

the application includes the ***T-shaped*** structure and the ***adjustment assembly selectively movable to vary the relative positions of the first and second faces*** to eliminate looseness which may exist in mounting said wear member as set forth in amendment A.

***New Matter***

3. The amendment filed 10/10/01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The limitation of "a mount" claims 74, 91, 114, 115, "a one-piece boss" claims 103, 111, and "a coupling slot" claim 103.

Applicant is required to cancel the new matter in the reply to this Office action.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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74-80, 84-87, 111, 112, 102-110  
113, 114  
5. Claims 74-87, ~~91-99, 103, 107, 114~~ are rejected under 35

U.S.C. 102(b) as being anticipated by Jones (5,088,214).

Jones '214 discloses a wear assembly having all of applicant's claimed structure including a mount (considered boss 29), a wear member including a second shoulder and an opening, and a lock 38 received in the opening in the wear member to prevent disconnection of the first and second shoulders and thereby retain the wear member to the mount as shown in figure 10. Jones '214 also discloses a keeper assembly 45.

6. Claims 88-90, ~~100-102, 104-106~~, 115-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (5,088,214) in view of Jones et al. (4,433,496).

Jones '214 discloses a wear assembly having essentially all of applicant's claimed structure as described previously, but lacks the lock including an adjustment assembly movable to tighten the fit of the lock between the wear member and the mount.

Jones et al. '496 teaches that it is known in the art to use a lock including an adjustment assembly movable to tighten the fit of the lock and eliminate looseness in the wear assembly.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made, to modify the wear assembly of Jones (5,088,214) by using a lock with an adjustment

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assembly as taught by Jones et al. '496, to eliminate looseness in the wear assembly.

***Allowable Subject Matter***

7. Claims 1-73 are allowed.

**Inquiries**

8. Any inquiry concerning this communication should be directed to Examiner Victor Batson whose telephone number is (703) 305-6356. The examiner can be normally reached Monday through Friday (except Wednesday) from 7:00 am to 5:00 pm, Eastern Standard Time.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will, can be reached on (703) 308-3870. The fax phone number for this Group is (703) 305-3597.

November 15, 2001



Victor Batson  
Primary Examiner  
Art Unit 3671